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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/698,903	10/27/2000	Brigitte Weston	514412-2020.1	8217

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EXAMINER

MOONAN, FRANCIS P

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 04/05/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/698,903	WESTON ET AL.
	Examiner	Art Unit
	Francis P Moonan	1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 16 January 2002.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 23-34 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) \_\_\_\_\_ is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) 23-34 are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.

4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

### DETAILED ACTION

Application No. 09/698,903 filed on 27 October 2001 is a Continuation-In-Part of Application No.09/430,497 filed on 29 October 1999.

Applicants elect with traverse in Paper No. 13, filed on 14 January 2002, Group III, Claims 17-18, drawn to kits comprising at least two PCR-derived probes , in response to the restriction requirement of Paper No.11 filed on 14 December 2002.

In Paper No. 13, filed on 14 January 2002, applicants requested cancellation of Claims 1-22. Claims 1-22 have been cancelled.

In Paper No. 13, filed on 14 January 2002, applicants requested Claims 23-34 be newly added. Applicants' request is acknowledged and newly added Claims 23-34 have been entered.

In Paper No. 13, on page 4, lines 1-3; and on page 4 line 20 to page 5, line 2 , of Paper No. 13, applicants request reconsideration of the restriction requirement, in light of the cancellation of Claims 1-22 and the newly added Claims 23-34.

Accordingly, the examiner has reconsidered the restriction requirement, and Claims 23-34 are restricted in the Office Action that follows.

#### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I. Claims 23-28 and 33-34, drawn to method of identifying a male-sterile transgenic *Brassica* plant, seed, or parts thereof, by probing immobilized transgenic plant nucleic acids by chemical hybridization with a DNA fragment , or by PCR amplification of transgenic plant DNA templates, classified for example in class 800, subclass 303.

Group II. Claims 29-32, drawn to PCR kits comprising at least two oligonucleotide primers, classified for example in class 536, subclass 24.3.

The inventions are distinct, each from the other because:

The inventions of Group II and Groups I are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that

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product (MPEP § 806.05(h)). In the instant case, the method of Group I may be practiced with a materially different product, and the product of Group II may be independently used in a materially different process such as diagnostic processes unrelated to the diagnostics processes of plants of the invention of Group I.

The invention of Group I includes methods of utilizing molecular marker-aided identification of *Brassica* plants transformed with transgenes, whose specific insertion into the genome, by concerted action of enhancer sequences in the locality of the insertion into the plant genome, comprising a modification to the expression of a tapetal-specific promoter derived from a non-*Brassica* plant genome, such that the cell-lethal phenotype conferred by the expression of a barnase-derived transgene is localized to cells of the anther, such that the resulting phenotype of the *Brassica* plant is male-sterility. The invention of Group II is a kit product comprising at least two oligonucleotide primers. The method invention of Group I utilizes DNA fragment products as probes in chemical hybridization processes that produce diagnostic molecular marker fragment patterns, for example by Southern blot and restriction fragment length polymorphism (RFLP) analysis, that are not required of the invention of Group II. The product invention of Group II may be used in diagnostic processes of any virus or organism which has a nucleic acid comprising genome, and can be used as diagnostics for a variety of independent uses, because the invention of Group II comprises a set of an unspecified number of oligonucleotide primers, in addition to the recited oligonucleotide primers of SEQ ID NO:8, SEQ ID NO:10, or SEQ ID NO:11. The invention of Group II may be utilized with any nucleic acid template, and therefore non-plant diagnostics, that are processes independent and distinct from the process of Group I.

Furthermore, the inventions of Groups I and II may be classified in distinctly different classes, and a search of all inventions would place an undue burden on the examiner.

Because these inventions are independent and distinct for the reasons stated above and have acquired a separate status in the art as shown by their different classification, the search for one group is not required of the others, and a search of all of the Groups would place an undue burden of search on the examiner, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the

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currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Francis Moonan, whose telephone number is (703) 605-1201. The examiner can normally be reached on Monday through Friday 9:00 AM to 5:00 PM (E.S.T.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached at (703) 306-3218. The fax phone number for this Group is (703) 308-4315. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Francis Moonan, Ph. D.

1 April 2002

DAVID T. FOX  
PRIMARY EXAMINER  
GROUP 180 1638

